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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,247	09/28/2001	Clark Thurston Hill	END920010029US1	5158
23550	7590	06/07/2006	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			SMITH, TRACI L	
75 STATE STREET			ART UNIT	
14TH FLOOR			PAPER NUMBER	
ALBANY, NY 12207			3629	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/966,247	HILL, CLARK THURSTON	
	<b>Examiner</b>	<b>Art Unit</b>	
	Traci L. Smith	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This action is in response to papers filed on April 24, 2006.

No claims have been amended.

Claims 1-34 are pending.

Claims 1-34 are rejected.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-34 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,790,429 Baker et al. Mailing Coding System.

3. As to claims 1, 8, 16, 20, 28 and 33 Baker teaches

- unique identifiers and electronically associating a mailing address enough to route the mail. (C. 2 I. 31-36).

- putting a barcode on the parcel (C. 2 I. 52-54).

- Routing the parcel (C. 4 I. 30-32).

4. As to claims 2, 14 and 25 and electronically editing see C. 8 I. 58-61

5. As to claims 3 and 26 Baker teaches routing the parcel to recipient see C. 9 I. 66-67.

6. As to claims 4-5, 9-10, 17-18, 23-24 and 32 Baker teaches barcode see C. 4 l. 31-32.

7. As to claims 6, 13 and 31 Baker teaches sending the parcel to receive the barcode before routing. Although Baker does not explicitly state the barcode before it gets routed the examiner states it is inherent that if the barcode is going to be used for routing it must be complete and in place before the package is routed. The barcode is taking the place of the address, is it not required to have an address on an envelope to deliver it correctly.

8. As to claims 7, 15, 19, 27, 29 and 34 Baker teaches the machine identifying there is not enough of the address present to complete the barcode and requesting more information(C. 8 l. 58-60)

9. As to claims 11, 21 and 30 Baker teaches the address as a physical address(C. 8 l. 42-45). The examiner makes note that although the reference teaches a physical address this aspect is inherent in the mailing industry. In order for the mail to be delivered it needs an actual location for which to be delivered to.

10. As to claims 12 and 22 Baker teaches the machine as a postal machine(C. 3 l. 64-67).

### ***Response to Arguments***

11. Applicant's arguments filed April 24, 2006 have been fully considered but they are not persuasive.

12. Applicant maintains arguments that Baker fails to teach an identifier that is being used "in lieu of a mailing address". The examiner notes that Baker is using a barcode

associated with a recipients mailing address for the purpose of routing mail via an electronic barcode. That fact that Baker may contain additional information on the mail piece does not render the rejection improper. Baker contains all the limitations of the instant application. Baker does not teach a process of affixing a mailing address to the mail piece as described by the applicant. The addresses are simply presented to the operator to be entered in the system used to create the barcode. The address can be located on a separate spreadsheet or database, the addressed used by Baker is not identified as being placed on the mail piece. Applicant previously argued in papers filed on January 23, 2006 that Baker teaches methods of generating the barcode for affixing to the mail. In one aspect the address is taken directly from the mail piece, identified by applicant as taking place in C. 9 I. 64-65. However, upon additional review of this section it says nothing that the barcode is printed on the same item in which the address is take. The section merely states: *"In contrast, if a print codes has been assigned, then control flows to step 388 and the corresponding barcode is printed with printer on detected mail piece."* This is interpreted by the examiner to mean that the mail piece has moved along in the system and is not detected by control system as having sufficient information needed to print the proper barcode on the mail piece.

### **Conclusion**

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.

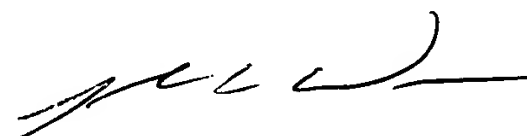
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLS



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